

Remarks

The various parts of the Office Action are discussed below under similar headings.

Drawings

The drawings were amended as described above. Replacement sheets are provided for Figures 1, 8 and 9.

Specification

The Examiner objected to portions of the specification. Paragraphs [0036] and [0046] have been amended to address the Examiner's objections. Accordingly, these objections should be withdrawn. Paragraphs [0047], [0051-0058], [0060] and [0072] have been amended to correspond with the replacement drawing sheets.

Claim Objections

The Examiner objected to claims 2, 3 and 13 based on certain informalities. Pursuant to the Examiner's request, these claims have been amended to remove the informalities. Accordingly, these objections should be withdrawn.

Claim Rejections - 35 U.S.C. § 101

Claims 1-19 have been amended as suggested by the Examiner. Accordingly, the rejection based on 35 U.S.C. § 101 is now believed to be moot and this rejection should be withdrawn.

Claim Rejections - 35 U.S.C. § 102 and § 103

The Examiner rejected claims 1-13 under 35 U.S.C. §102(b) as a being anticipated by a mental process in a human being augmented by a sheet of paper and pencil. This rejection is now believed to be moot in view of the amended claims. Therefore, the rejection under 35 U.S.C. §102(b) should be withdrawn.

The Examiner also alleged that claims 1-13 were unpatentable under 35 U.S.C. §103(a) over DeLeeuw et al. (U.S. Patent No. 6,088,018 ("DeLeeuw")) in view of Dehli (U.S. Patent No. 5,638,156 ("Dehli")). Claims 1-13 have been amended. Accordingly, the rejection of original claims 1-13 is rendered moot.

According to MPEP §2142, three basis criteria must be met for the Examiner to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also *In re Dembiczaak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

It is noted that the Examiner combined DeLeeuw with Dehli to allegedly arrive at original claims 1-13. It is noted, however, that the Examiner did not identify any suggestion or motivation to modify or otherwise combine DeLeeuw with Dehli. Absent some suggestion or motivation to combine the references, such a combination of references is improper.

In this instance, the Examiner contends that DeLeeuw clearly teaches the limitations of the claimed invention except explicitly teaching certain details of the image merge process. The Examiner further contends that Dehli discloses all the techniques of the stated method, except that a computer does not perform the method. The Examiner then draws the conclusion, without directing the Applicant to support in either reference or knowledge generally available to one of ordinary skill in the art, that it would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the references. (December 18, 2004 Office Action at Page 8). As stated above, without some suggestion or motivation to combine the references, such a combination of references is improper. Therefore, Applicant respectfully submits that the Examiner has not made a *prima facie* case for obviousness.

Moreover, it is unlikely that one of ordinary skill in the art would be motivated to combine the teaching of DeLeeuw with the teachings of Dehli. Combining the apparatus of DeLeeuw and the image fabrication method of Dehli would allow multiple video images to be projected onto the monitor of DeLeeuw instead of simply one, as believed to be disclosed in DeLeeuw. In addition, the multiple images would also overlap slightly, which would, in turn, result in blurring of both images. Therefore, combining the

apparatus of DeLeeuw with the image fabrication method of Dehli would destroy the intended purpose of DeLeeuw. Where obviousness is based upon a modification of a reference that destroys the intended purpose or function disclosed in a reference, there is no motivation for engaging in the modification. *Schneider (Europe) AG v. SciMed Life Systems, Inc.*, 852 F.Supp. 813, 853-854 (D. Minn., 1994)(citing *In re Gordon*, 733 F.2d 900, 902 (Fed.Cir.1984).

Even if the combination of DeLeeuw and Dehli was proper, the end result would not teach the amended claims. Amended claim 1 recites, *inter alia*, a computer implemented process for the creation of a merged image comprising the steps of: a. preparing at least two base images in digital format... f. merging of only the selected mergable portions of each respective base image into the merged image template to provide a single layer merged image.

The apparatus of DeLeeuw and the image fabrication method of Dehli have notable differences between the claimed invention. First, the claimed invention utilizes images in digital format, as opposed to operations performed on photosensitive film (e.g., portions of a sheet of film (Abstract), film negatives (Col. 4, lines 3-8)) required by Dehli. Second, Dehli is directed to overcoming "white flash" and, therefore, teaches that "succeeding exposed pixels are positioned in a slightly overlapping fashion to cause a double exposure border between the pixels" (column 3, lines 23 to 26). Such a feature is not required with the present invention due to the precision of the computer implemented process and the creation of a single layer image, as set forth in amended claim 1.

It is further submitted that Dehli teaches the use of a process that is contrary to that of the present invention, a person skilled in the art would not combine the apparatus of DeLeeuw with the process in Dehli to arrive at the invention of amended claim 1. The present invention seeks to overcome a problem solved by Dehli in a new manner namely, by merging the mergable portions of the respective base images and specifically not overlapping the portions. The Examiner's citation to *In re Venner*, 120 USPQ 192 (CCPA 1958) is inapposite because the present invention does not accomplish the same result as either DeLeeuw or Dehli.

For at least these reasons, the combination of references suggested by the Examiner does not and cannot achieve the invention, as defined in amended claim 1 and amended claims 2-13, which depend therefrom. Therefore, Applicant respectfully submits that the process defined in amended claims 1-13 is patentable over DeLeeuw and Dehli, either alone or in combination.

Likewise, amended claims 14-19 are now dependent on amended claim 1. Therefore, claims 14-19 are patentable for at least the same reasons set forth above for amended claims 1-13. The additional references made of record by the Examiner, namely, Morris, Yokomizo, Kimura and Ginter, either alone or in combination, fail to cure the deficiencies resulting from the combination of DeLeeuw and Dehli. Accordingly, amended claims 14-19 are patentable over the cited references either alone or in combination with DeLeeuw and/or Dehli.

Conclusion

In view of the foregoing, request is made for timely issuance of a notice of allowance.

Respectfully submitted,

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CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this paper (along with any paper or thing referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: 4/18/05

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Amendments to the Drawings

A replacement sheet for Figures 1, 8 and 9 is submitted herewith. Figure 1 was amended for uniformity purposes; Figure 8 was amended to delete the seven referenced steps objected to by the Examiner; and Figure 9 was amended by deleting the "FIGURE 9" text.

Attachments: Replacement Sheets for Figure 1, 8 and 9.